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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/641,378	01/28/2004	James W. Schick JR.	074309.000014	6676

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EXAMINER

WIEKER, AMANDA FLYNN

ART UNIT	PAPER NUMBER
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3743

DATE MAILED: 03/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/641,378	Applicant(s) SCHIEK, JAMES W.	
	Examiner Amanda F. Wieker	Art Unit 3743	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 23 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 March 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>4/30/01</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Status of Application*

1. Applicant filed a Declaration for Reissue on 18 August 2000.
2. On 18 January 2000, a Notice of Incomplete Application was mailed.
3. On 26 March 2002 Applicant filed a Response to the Notice of Incomplete Application including a Petition to Waive Rules Under 1.183; 2 sheets of Drawings; and a copy of the Declaration filed on 18 August 2000.
4. On 05 August 2002, the Petition to Waive Rules Under 1.183 was dismissed.
5. On 11 June 2003 the case was held as Abandoned.
6. Applicant filed a Communication to the Office of Petitions, on 18 December 2003, outlining the status of the Petitions in the case.
7. On 07 January 2004, the Petition to Waive Rules Under 1.183 was granted, the Petition Under 37 CFR 1.47(b) was dismissed, and the holding of Abandonment was withdrawn.
8. On 28 January 2004, Applicant filed a Supplemental Declaration for Reissue.
9. On 08 March 2004, the Petition Under 37 CFR 1.47(b) was granted.

### *Claim Objections*

10. In the Declaration for Reissue filed on 18 August 2000, Applicant amended claims 1, 2, 5, 7 and 8, and added new claim 12. In the Supplemental Declaration for Reissue filed on 28 January 2004, Applicant added new claims 12-15. Please note that these two versions of claim 12 are of different scope.

It is noted that two different versions of claim 12 have been added. The examiner believes that the most recently added claim 12 (filed 1/28/04) is the claim that Applicant

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intends to present for examination, because it is the claim version filed most recently, and new claims 13-15 have also been added, wherein claims 13-15 depend from claim 12. The examiner is examining the case under this assumption. Applicant is required to submit a complete listing of the claims in response to this Office Action, to clearly identify which claims remain under examination.

11. Claims 5, 7, 8 and 12 are objected to because of the following informalities:

In line 1 of claim 5, subsection (b) it appears that the word "strap" should be deleted from the phrase "comprising a second strap hook and loop fastener".

In claim 7, due to the deletion of subsection (f), the subsections of the claim are discontinuous and confusing. The claim now has subsections (a), (b,) (c), (d), (e,) (g) and (h). It is suggested that the claim be amended to provide continuous subsections (a)-(g).

In claim 8, there is insufficient antecedent basis for "the fastener" and "the flap" in the claim.

In line 19 (of text) of claim 12, it appears that the word --to-- should be inserted before the phrase "accommodate bending".

Appropriate correction is required.

### *Reissue Application*

12. Claims 1-15 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Pannu v. Storz Instruments Inc.*, 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001); *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir.

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1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to claim subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope of claim subject matter surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

13. In Applicant's Declarations for Reissue, Applicant states that claims 1 and 7 have been amended to delete the references to *two* fastening means, and instead simply recite *a* fastening means. Dependent claims 2, 5 and 8 have been amended to encompass the language deleted from claims 1 and 7. Added claims 12-15 (1/28/04) appear to recite a "securable fastener" but do not recite the specifics of the two-part fastening means recited in patent claims 1 and 7. Applicant states that "the novelty of the invention does not arise in the recited fastening means" and that the "invention lies in the uniquely contoured shape of the support belt" as "evidenced in the lengthy examination and appeal process in which the non-obviousness of the contoured shape was established by the Board of Patent Appeals and Interferences." Applicant cites this rationale as to why the Reissue amendments are proper.

The examiner disagrees. During prosecution of the parent case Applicant added claim 1 (claim 18, during examination) and amended claim 7 (claim 9, during examination) on 15 August 1994, to include the subject matter that is now cancelled by this Reissue Application. Specifically, on 15 August 1994, Applicant filed an amendment in which claim 18 was added

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and claim 9 was amended to include the specifics of the first and second fastening means, in order to overcome the Examiner's rejection of the claims.

See Applicant's comments, filed 15 August 1994, on pages 6-7 and reproduced here:

"Applicant believes the invention to be the use of a base with a releasably, securable first fastening means in combination with a strap having a second, cinchable fastening means."

"None of the prior art shows a belt having a base with a first fastening means, coupled with a strap having an independent second fastening means."

"Pursuant to the Examiner's comments, new independent claim 18 and claims 19-20 depending therefrom, have been added and claim 9 has been amended to substantially include the structural features of claims 1, 2 and 4 and to now claim an invention which is structurally distinct from the prior art. Applicant's invention, as now claimed in new claims 18-20 and amended claim 9 is directed to a belt including an elongate base with opposite ends including a first fastening means and a strap having opposite ends which extend beyond the base having a second, cinchable fastening means."

It is improper for Applicant to now cancel the subject matter that was added to the claims to overcome a prior art rejection. The newly claimed subject matter has been surrendered and cannot be recaptured by the filing of the present reissue application.

See MPEP 1412.02: "If an original patent claim limitation now being omitted or broadened in the present reissue application was originally relied upon by applicant in the original application to make the claims allowable over the art, the omitted limitation relates to subject matter previously surrendered by applicant."

14. Applicant points to the comments published in the Board decision to support the assertion that the "invention lies in the uniquely contoured shape of the support belt".

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Applicant appears to assume that based on the Board's comments, the two-part fastening means recited in the patent claims do not impact the novelty or non-obviousness to the invention.

The examiner points out that the Board's decision of non-obviousness, as based on secondary considerations of commercial success and copying by competitors, was based on the claims as patented which include the combination of a belt with a contoured shape, and with the claimed two-part fastening system. Applicant cannot presume that the Board would maintain the same holding of non-obviousness when faced with claims of different scope and having a different fact pattern than that presented to the Board for consideration. The Board's sole holding of non-obviousness is based on independent claims that include 1) reduced side sections; 2) a first fastening means; and 3) a second fastening means.

*Claim Rejections - 35 USC § 112*

15. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

16. Claims 7 and 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

17. In claim 7, subsections (g) and (h) recite:

“g. an elongate strap of flexible, generally non-stretchable material secured adjacent one base end and coaxial with the base, and having a free end; and

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h. a cinchable fastening means secured to the other base end and adapted to be received in and secured by said elongated strap and cinched to fit when the belt is placed around the waist of the wearer.”

It is unclear to the examiner how the “cinchable fastening means” can be received in said “elongated strap”. The elongated strap (24) is received in the buckle (38) and the strap is cinched to tighten. It appears that perhaps these subsections are intended to be written as:

--g. an elongate strap of flexible, generally non-stretchable material secured adjacent one base end and coaxial with the base, and having a free end; and

h. a ~~cinchable~~ fastening means secured to the other base end and adapted to receive be ~~received in and secured by~~ said elongated strap and to cinch said strap ~~cinched~~ to fit when the belt is placed around the waist of the wearer. —

Claim 7 is being examined under this interpretation.

18. In claim 8, there is insufficient antecedent basis in the claim for the claim elements of “the fastener” and “the flap”. Because these elements have not been introduced into the claim, it is unclear where the recited hook and loop pads are located. Is Applicant referring to the hook and loop pads 44, 46? Or is Applicant referring to the strap’s hook and loop pads 40, 42?

Because claim 7 recites features of the strap, the examiner will interpret claim 8 under the assumption that it is referring to the hook and loop fasteners associated with the free end of the strap.

#### *Claim Rejections - 35 USC § 102*

19. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:



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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

20. Claims 1, 12 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S.

Patent Number 2,185,834 to Creper.

Regarding claim 1, Creper discloses a support belt adapted for encircling and being secured to the waist of a wearer for providing both back and abdominal muscle support during strenuous activity while providing a non-interfering support and a non-interfering fit with the skeletal structure of the ribs and hips of the wearer, the belt comprising:

a. an elongate base (10) having a longitudinal axis and opposite outer ends (at 25, 29) and of a length sufficient to encircle the waist of the wearer, the base including an enlarged back support area (15) and an enlarged abdominal support area (16), each area of a first fixed predetermined vertical height and each area being integral within the base, the areas being disposed within the base such that the areas are opposite one another when the belt is encircling the waist of the wearer (see Figure 1);

b. reduced side areas (13, 14) within the base, having a second predetermined vertical height smaller than said first predetermined vertical height and disposed intermediately of the back support and abdominal support areas and opposite one another between the hips and ribs of the wearer when the belt is encircling the waist, said reduced side areas being sized to allow the belt to be sufficiently tightened against the back and abdominal walls without encountering the skeletal structure of the ribs or hips of the wearer thereby evenly distributing and providing optimum support to both the back and abdominal walls and accommodate bending and side-to-side motion of the wearer (col. 2, lines 10-17); and

c. a first fastening means (24) for releasably securing the belt to encircle the waist of the wearer.

Regarding claim 12 (filed 1/28/04), Creper discloses a support belt adapted for encircling and being secured to the waist of a wearer for providing both back and abdominal muscle support during: strenuous activity while providing a non-interfering support and a non-interfering fit with the skeletal structure of the ribs and hips of the wearer, the belt comprising:

a. an elongate base (10) having a longitudinal axis and opposite outer ends (at 25, 29) and of a length sufficient to encircle the waist of the wearer, the base including an enlarged back support area (15) and an enlarged abdominal support area (16), each area having its own first fixed predetermined vertical height, the areas being disposed on the base such that the areas are opposite one another when the belt is encircling the waist of the wearer;

b. reduced side areas (13, 14) on the base having a second predetermined vertical height smaller than said first predetermined vertical height of either support area and disposed intermediately of the back support and abdominal support areas and opposite one another between the hips and ribs of the wearer when the belt is encircling the waist, said reduced side areas being sized to allow the belt to be sufficiently tightened against the back and abdominal walls without encountering the skeletal structure of the ribs or hips of the wearer thereby evenly distributing and providing support to both the back and abdominal walls and to accommodate bending and side-to-side motion of the wearer; and

c. a releasably securable fastener (24) disposed on said base to permit said opposite outer ends to be secured adjacent one another when the belt is encircling the waist of the wearer.

Regarding claim 15, Creper discloses that the enlarged abdominal support area comprises an enlarged first abdominal support portion (left end, Figure 2) located on one outer

end (25) of the base; and an enlarged second abdominal support portion (right end, Figure 2) located on the other outer end (29) of the base.

*Claim Rejections - 35 USC § 103*

21. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

22. Claims 5 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Creper in view of U.S. Patent Number 4,964,401 to Taigen.

Creper discloses the previously described support belt having a first fastening means (24). Creper discloses that the first fastening means further comprise a first pad portion (left end, Figure 2) at one end (25) of the base; and a second pad portion (right end, Figure 2) disposed at the other outer end (29) of the base, the first and second pad portions adapted to be placed in overlying, releasably secured relationship with one another when the belt is encircling the waist of the user (see Figure 1). Creper discloses that the first pad comprises a first fastener (24), and the second pad portion comprises a second fastener (26/27/28) complementary with the first fastener. Creper does not specify that the first and second fasteners be pads of complementary hook-and-loop material.

Taigen discloses a support belt having a first pad portion (left end, Figure 1-2) at one end of the base; and a second pad portion (right end, Figure 1-2) disposed at the other outer end of the base, the first and second pad portions adapted to be placed in overlying, releasably

secured relationship with one another when the belt is encircling the waist of the user (see Figures 3 and 6). Taigen specifies that the first pad portion comprises a first hook and loop fastener pad (38), and the second pad portion comprises a second hook and loop fastener pad (40) complementary with the first fastener pad, to provide an initial self-gripping securement of the belt to the user.

It would have been obvious to one skilled in the art at the time the invention was made to have provided the support belt disclosed by Creper, wherein the complementary fasteners on the first and second pad portions are hook-and-loop fastener pads, as taught by Taigen, to provide an initial self-gripping securement of the belt to the user.

23. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Creper in view of U.S. Patent Number 1,600,027 to Wesland.

Creper discloses the previously described support belt. Creper does not specify that the belt include utility rings.

Wesland discloses a support belt (10) having conventional utility rings (11) for securement and safety, capable of securing the belt directly to an implement to be moved or lifted.

It would have been obvious to one skilled in the art at the time the invention was made to have provided the support belt disclosed by Creper, wherein the support belt includes utility rings, as taught by Wesland, to provide added securement and safety to the belt.

24. Claims 7, 8, 11 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Creper in view of U.S. Patent Number 4,964,401 to Taigen.

Creper discloses a support belt adapted for encircling and being secured to the waist of a wearer for providing both back and abdominal muscle support during strenuous activity while providing a non-interfering fit with the skeletal structure of the ribs and hips of the wearer, the belt comprising:

a. an elongate base (10) having a longitudinal axis and opposite outer ends (at 25, 29) and made of a flexible material (loosely woven canvas) to accommodate the various movements of the waist and associated placement of the hips and ribs of the wearer;

b. an enlarged back support area (15) having a first fixed predetermined vertical height and integral within the base such that the area supports the back of the wearer when the belt is encircling the waist of the wearer (see Figure 1);

c. an enlarged first abdominal support portion located on one outer end (25) of the base and having a fixed predetermined vertical height substantially the same as the first fixed predetermined vertical height of the back support and positioned to define an abdominal support area opposite the back support area and located in the vicinity of the abdominal wall of the wearer when the belt is encircling the waist;

d. an enlarged second abdominal support portion located on the other outer end (29) of the base and the first abdominal support portion located on one outer end of the base and having a fixed predetermined vertical height coexistent with said first abdominal support height and positioned such that the abdominal support area is diametrically opposite the back support area and is located in the vicinity of the abdominal wall of the wearer when the belt is encircling the waist, said abdominal support portions adapted to be located in overlying relationship with one another when the belt is encircling the waist (see Figure 1, 3)

e. reduced side sections (13, 14) of the base having a second predetermined vertical height smaller than said first predetermined vertical height and located on the base intermediately of the back support and abdominal support areas and opposite one another between the hips and ribs of the wearer when the belt is encircling the waist, said reduced side areas being sized to allow the belt to be sufficiently tightened against the back and abdominal walls without encountering the skeletal structure of the ribs or hips of the wearer thereby evenly distributing and providing optimum support to both the back and abdominal walls (col. 2, lines 10-17); and

a fastening means for releasably securing the belt to encircle the waist of the wearer. Creper does not specify that the fastening means comprise an elongate strap of material.

Taigen discloses a support belt to be secured about the waist of a user, having an elongate base (10) with opposite outer ends, and comprising an elongate strap (56) of flexible, generally non-stretchable material secured adjacent one base end and coaxial with the base, and having a free end (at 58); and a fastening means (buckle, 50) secured to the other base end and adapted to receive said elongated strap and to cinch said strap to fit when the belt is placed around the waist of the wearer (see Figure 3), to provide tenacious and certain securement of the belt to the user. Taigen also discloses a hook and loop fastener pad (58) on the strap, and a second hook and loop fastener pad (54) on the base of the belt that is complementary with the first pad, to secure the free end of the strap to the belt.

It would have been obvious to one skilled in the art at the time the invention was made to have provided the support belt disclosed by Creper, wherein the fastening means on the belt comprises an elongate strap and a fastening means to receive and cinch the strap, as taught by Taigen, to provide tenacious and certain securement of the belt to the user.

Creper in view of Taigen discloses the previously described support belt. Creper does not specify vertical height of the portions of the support belt.

However, at the time the invention was made, it would have been an obvious matter of design choice to one of ordinary skill in the art to have made the belt disclosed by Creper with the claimed dimensions, or any other dimensions deemed appropriate to securely fit the support belt to a selected user, because Applicant has not disclosed that such dimensions provide an advantage, are used for a particular purpose, or solve a stated problem. One of ordinary skill in the art, furthermore, would have expected Creper's orthosis and Applicant's invention to perform equally well with either the dimensions used by Creper, or the claimed dimensions because both dimensions would perform the same function of securing the belt to the selected user.

Therefore, it would have been *prima facie* obvious to modify Creper in view of Taigen to obtain the invention as specified in the claims because such a modification would have been considered a mere design consideration which fails to patentably distinguish over the prior art of Creper in view of Taigen.

25. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Creper in view of Taigen and in view of U.S. Patent Number 1,600,027 to Wesland.

Creper in view of Taigen discloses the previously described support belt. Creper does not specify that the belt include utility rings.

Wesland discloses a support belt (10) having conventional utility rings (11) for securement and safety, capable of securing the belt directly to an implement to be moved or lifted.

It would have been obvious to one skilled in the art at the time the invention was made to have provided the support belt disclosed by Creper in view of Taigen, wherein the support belt includes utility rings, as taught by Wesland, to provide added securement and safety to the belt.

*Conclusion*

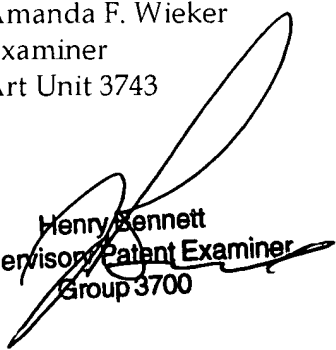
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amanda F. Wieker whose telephone number is 571-272-4794. The examiner can normally be reached on Monday-Thursday, 7:30 - 5:00 and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry Bennett can be reached on 571-272-4791. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
afw

Amanda F. Wieker  
Examiner  
Art Unit 3743

  
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